

Remarks

In response to the Examiner's instructions, the Applicant has canceled non-elected claims 1-8.

The Examiner continued her rejection of claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Bobrov-Egorov et al. in view of Yokoyama, Leontev et al., Karita et al., and Pike, and further in view of Zobitne et al. and Lawless. The Examiner stated that "Bobrov-Egorov teaches a composition comprising the following ingredients (wt. %): (i) an aromatizing component (0.5-20.0) comprising essential oil derived from mint, fir, coriander, anise, camphor, dill, cloves or fennel and containing a toning preparation (not more than 0.2% of base weight) comprising vanilla and/or oil extracted from filbert, chestnut, pine kernels, walnut, sea buckthorn and/or dog rose; oil extracts from everlastings, Leonorus, yarrow, celandine, thyme, Origanum, St. John's wort, peppermint, sage, dog rose fruit, coriander, caraway, horse chestnut, pine buds and calendula blossom (balance)...Bobrov-Egorov further teaches that the referenced composition has analgesic activity; and is useful in medicine, particularly gynecology." The Examiner further stated that "Bobrov-Egorov teaches the instantly claimed invention except for cornmint oil (although it is not clear as whether the mint oil taught by Bobrov-Egorov is not cornmint oil), orange oil, pennyroyal oil, and rosemary Spanish oil...[and that] it would have been obvious...to add the instantly claimed ingredients to the composition taught by Bobrov-Egorov to provided the claimed invention because...it was known in the art the analgesic effects of the claim designated essential oils." The Examiner still further states that Yokoyama teaches a composition "comprising an essential oil of *Mentha arvensis* an analgesic agent, which is also known in the art as cornmint, as evidenced by the teaches of Zobitne." Also, the Examiner states

that “Zobitne...teaches that cornmint oil includes...alpha-pinene and beta-pinene...[and that] Law teaches that cornmint oil comprises methyl acetate.” Next, the Examiner states that Leontev teaches a composition having anesthetic activity comprising a Component I (camphor and mint oil) and a Component II (any of the following oils: coriander, orange, rose, peppermint, calendula, etc.). Next, the Examiner states that Karita teaches an analgesic oil composition comprising at least one oil selected from orange oil, grapefruit oil, mandarin oil and lemon oil, and one oil selected from lavender oil, lavandin oil and rosemary oil, and at least one oil selected from eucalyptus oil, chamomile oil, Taiwan hinoki and mugwort oil. The Examiner also states that Karita teaches that pennyroyal oil, *menthe arvensis* oil and rosemary oil are useful in making Karita’s analgesic composition. Next, the Examiner states that Pike teaches a composition for alleviating cramps, aches and pains, such as those associates with premenstrual syndrome, comprising pennyroyal oil. In sum, the Examiner states that one skilled in the art would have been motivated and would have had a reasonable expectation of success to add effective amounts of cornmint oil, orange oil, pennyroyal oil, and rosemary Spanish oil to Bobrov-Egorov’s composition to provide the Applicant’s claimed composition because Yokoyama, Leontev, Karita and Pike teach that these ingredients are use for reducing menstruation pain. Finally, the Examiner concludes that each of the references indicates that the various proportions and amounts of the claimed composition are result variables and they would have been routinely optimized by one of ordinary skill in the art.

The Applicant respectfully traverses the Examiner’s rejection. In addition to reiterating the Applicant’s arguments presented in the previous Response filed on July 13, 2005, the Applicant offers the following additional arguments.

Obviousness is predicated on four underlying issues of fact, (1) the scope and content of the prior art, (2) the differences between the claims and the prior art, (3) the level of ordinary skill in the art, (4) and secondary considerations of nonobviousness including commercial success, long felt but unresolved need, failure of others, copying, and unexpected results. Ruiz v. A.B. Chance, supra, citing, Graham v. John Deer Co., 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966) and Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 877, 27 U.S.P.Q.2d 1123, 1228 (Fed. Cir. 1993); and McGinley, supra, citing, Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966) and Kegel Co., Inc. v. AMF Bowling, Inc., 127 F.3d 1420, 1430, 44 U.S.P.Q.2d 1123, 1130 (Fed. Cir. 1997). These are the so called Graham factors.

With regard to secondary considerations, “[t]he so-called ‘secondary considerations’ provide evidence of how the patented device is viewed by the interested public: not the inventor, but persons concerned with the product in the objective arena of the marketplace.” Arkie Lures Inc. v. Gene Larew Tackle Inc., 43 U.S.P.Q.2d 1294, 1297 (Fed. Cir. 1997); Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 7 U.S.P.Q.2d 1222, 1225 (Fed. Cir. 1988).

Secondary considerations of nonobviousness, as a matter of law, must be considered and are usually the most important evidence when considering the question of obviousness. Ruiz v. A.B. Chance Co., 57 U.S.P.Q.2d 1161, 1169 (Fed. Cir. 2000); Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538 (Fed. Cir. 1983). Secondary considerations of nonobviousness include commercial success, long felt but unresolved need, failure of others, copying, and unexpected results. Ruiz v. A.B. Chance, citing, Graham v. John Deer Co., 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966) and Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 877, 27 U.S.P.Q.2d 1123, 1228 (Fed. Cir. 1993).

[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art. Ruiz v. A.B. Chance Co., 57 U.S.P.Q.2d 1161, 1169 (Fed. Cir. 2000), quoting, Stratoflex, 713 F.2d at 1538, 218 U.S.P.Q. at 879) Such evidence 'may be sufficient to overcome a prima facie case of obviousness.' Ruiz v. A.B. Chance Co., 57 U.S.P.Q.2d at 1169, quoting, In re Beattie, 974 F.2d 1309, 1313, 24 U.S.P.Q.2d 1040, 1043 (Fed. Cir. 1992).

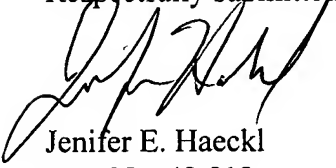
As in Litton Systems Inc. v. Honeywell, Inc., 39 U.S.P.Q.2d 1321, 1327 (Fed. Cir. 1996), here there is substantial evidence of secondary considerations of nonobviousness including, the commercial success enjoyed by the commercial product and the accolades from industry professionals for its contribution to the industry.

As described in the attached Declaration of Mr. Salmonson, the inventor of the subject invention and president of Claire Ellen Products, the company which sells the commercial product of the subject invention sold under the trademark Menastil®, the invention has achieved immediate commercial success and accolades from recognized authorities in the industry. Such evidence of commercial success, in addition to the differences between the cited prior art as presented by the Applicant in the prior Response to the March 2005 Office Action, establishes that the subject invention is not obvious in view of the cited prior art.

Each of the Examiner's rejections has been addressed. Accordingly, it is respectfully submitted that the application is in condition for allowance. Early and favorable action is requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned in Worcester, Massachusetts at (508) 791-8500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jenifer E. Haeckl", written over the printed name.

Jenifer E. Haeckl

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